

Serial No. 10/657,524

Amdt. in Response to Office Action mailed Sept. 7, 2006

UTILITY PATENT

B&D No. TN3481

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REMARKS

Applicant has amended Claim 1.

Currently pending in the application are Claims 1-9 and 17.

The Examiner rejected Claims 1 and 6-9 under 35 USC 102(b) as anticipated by EP 0 752 300 ("EP '300"). Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 1, as amended, calls for *inter alia* a fence assembly attached to the base. The fence assembly comprises a fixed fence fixedly attached to the base a movable fence removably connected to the fixed fence, the movable fence defining a first support plane, at least one of the fixed fence and the movable fence for contacting the workpiece, and an auxiliary fence disposed behind at least one of the fixed fence and the movable fence, and above a portion of the fixed fence, the auxiliary fence defining a second support plane substantially parallel to the first support plane, so that when the movable fence is removed no portion of the fence assembly is above the fixed fence and in front of the second support plane, allowing the auxiliary fence to contact the workpiece. The fixed fence, the movable fence and the auxiliary fence are disposed on one side of the blade.

The Examiner has argued that auxiliary fence 80 attached to movable fence 32 is behind movable fence 34, and that, when movable fence 34 is removed, auxiliary fence 80 remains and contacts the workpiece according to the claims. Applicant amended Claim 1 to explicitly define that the three claimed fence elements, i.e., the fixed fence, the movable fence and the auxiliary fence, are disposed on the same side of the blade. This is not shown in EP '300 as EP '300 shows

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auxiliary fence 80 being removed when the movable fence on the same side of the blade is removed.

By contradistinction, Claim 1 requires (a) "a fence assembly attached to the base and disposed to one side of the blade," (b) "a fixed fence fixedly attached to the base and disposed on the one side of the blade," (c) "a movable fence removably connected to the fixed fence and disposed on the one side of the blade," and (d) "an auxiliary fence disposed on the one side of the blade behind at least one of the fixed fence and the movable fence." Because EP '300 does not disclose such elements, it cannot anticipate Claim 1 and its dependent claims.

The Examiner also has argued that EP '300 has a fixed fence 48, a movable fence 60, and an auxiliary fence 80 disposed behind the fixed and movable fences, the auxiliary fence 80 contacting the workpiece when the movable fence 60 is removed. The Examiner alleges that the description in EP '300 of flap 60 as "optional" teaches or suggests that flap 60 is removable.

Assuming for the sake of argument such interpretation is correct, EP '300 would still not teach Claim 1 as amended. That is because, even if flap 60 were to be removed from movable fence 32, movable fence 32 would still be in front of auxiliary fence 80.

By contradistinction, Claim 1 requires "an auxiliary fence disposed ... behind at least one of the fixed fence and the movable fence, and above a portion of the fixed fence, the auxiliary fence defining a second support plane substantially parallel to the first support plane, so that when the movable fence is removed no portion of the fence assembly is above the fixed fence and in front of the second support plane, allowing the auxiliary fence to contact the workpiece." Being that movable fence 32 would remain in front of the second support plane and above the fixed fence 48, EP '300 cannot anticipate Claim 1 and its dependent claims.

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The Examiner rejected Claims 1 and 6-9 under 35 USC 103(a) as being unpatentable over US Patent No. 4,869,142 ("Sato") in view of US Patent No. 5,297,463 ("O'Banion") or EP '300. Reconsideration and withdrawal of these rejections are respectfully requested.

The Examiner has alleged that guard 37 in Sato is the claimed auxiliary guard disposed behind the fixed fence 3, when adjusted in such a manner. However, no prima facie case exists for such modification for several reasons.

First, Sato does not suggest the desirability of providing an auxiliary fence behind a fixed fence. According to the MPEP, "the prior art must suggest the desirability of the claimed invention." MPEP § 2143.01(I).

In the present case, Sato teaches maintaining guard 37 coplanar with fixed fence 3. Sato, col. 5, lns. 28-30 & lns. 42-44 ("First, the knob 38 locks the guard 37 so that the workpiece support surface of the fence 3 and the edge of the guard 37 assume the same position"; "the guard 37 is retracted and fixed by the knob 38 in order to prevent the guard 37 from protruding from the workpiece support surface of fence 37"). Guard 37 is kept coplanar so that it can be used as a cutting line indicator when a workpiece is disposed against it. Sato, col. 5, lns. 32-35. If guard 37 were to be placed behind the fixed fence 3, the user would not be able to use guard 37 as a cutting line indicator. Accordingly, Sato does not suggest the desirability of having an auxiliary fence behind a fixed fence and instead teaches away from such arrangement.

Furthermore, adjusting Sato's guard 37 so that it remains behind the fixed fence would render it unsatisfactory for its intended purpose. If the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V).

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As discussed above, guard 37 is kept coplanar so that it can be used as a cutting line indicator when a workpiece is disposed against it. Sato, col. 5, lns. 32-35. If guard 37 were to be placed behind the fixed fence 3, the user would not be able to use guard 37 as a cutting line indicator. Accordingly, the modification proposed by the Examiner renders Sato unsatisfactory for its intended purpose, i.e., having an accurate cutting line indicator. Therefore, no suggestion or motivation exists to adjust Sato as proposed by the Examiner.

Finally, the Examiner's proposed modification changes Sato's principles of operation. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01(VI).

In the present case, the principle of operation is that guard 37 is to be disposed coplanarly to fixed fence 3 so that it can be used as a cutting line indicator. By moving guard 37 rearwardly as suggested by the Examiner, the user would not be able to operate guard 37 as a cutting line indicator, thus changing Sato's principle of operation. Therefore, no *prima facie* case can exist.

Being that neither O'Banion nor EP '300 teach using an auxiliary fence that is non-coplanar to the fixed or movable fences and usable when the movable fence has been removed, the Sato/O'Banion and Sato/EP '300 combinations cannot render unpatentable Claim 1 and its dependent claims.

In view of the foregoing, Claims 1-9 and 17 are patentable and the application is believed to be in condition for formal allowance.

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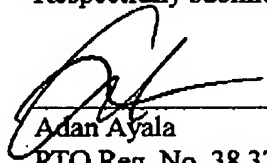
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No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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